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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,078	01/03/2002	Jorg Schreiber	BEIERSDORF 724-WCG	5707

7590 09/10/2004

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,078

Applicant(s)

SCHREILBER, JORG

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-38 is/are pending in the application.
- 4a) Of the above claim(s) 33-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of group I, claims 21-32 in the reply filed on June 8, 2004 is acknowledged. The traversal is on the ground(s) that the amended claims of group II, claims 33-38 now recites the method of making the composition of group I. This is not found persuasive because restriction is proper where the claimed composition can be prepared by a materially different process than the process claimed. Examiner reiterates that applicants admit that there are different processes to make microemulsion gel. See spec. p. 8, line 26 – p. 9, line 9. Should the composition claims be found allowable the process claims will be rejoined and the restriction requirement will be withdrawn. See MPEP § 821.04.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21 –32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21, the term “dilutable” renders the claim vague and indefinite. What is the standard to determine what is dilutable or non-dilutable? The claim merely requires an oil-in-water type transparent gel comprising an aqueous phase, an oil phase containing at least one phospholipids and at least one O/W

Art Unit: 1617

emulsifier. Furthermore, while the claims further recites that the water and oil phases are mixed "in a form that can be diluted", it is not clear what "form" it is that applicants are claiming. Does whether a composition can be diluted or not depend on how the composition is made? For the examination purposes, examiner takes the position that all O/W emulsions are "dilutable" by increasing the amount of the solute or the outer-phase, which is water.

Claims 26-32 are rejected as depending on cancelled claims.

Remaining claims are rejected as depending on indefinite base claim.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diec et al. (English translation of WO 96.28132) in view of Ponsanski (US 4567161).

Diec discloses transparent O/W microemulsion gel comprising an aqueous phase, an oil phase, and O/W emulsifier. See translation, p. 37, 2nd and 3rd full par. The reference teaches using up to 25 % by weight of O/W emulsifiers and optionally W/O emulsifiers. See p. 37, last full par.; instant claim 25. Example 10 shows a formulation comprising 6 % of cyclomethicone, which meets the oil phase requirement. See instant claim 25. See instant claim 25. UVA and UVB filters are taught in p. 40, 1st full par. – p. 41, 4th full par. See instant claim 28. Antioxidants are taught on p. 41, bridging par. – p. 43, 2nd par; instant claim 29. Examples 11 and 16 disclose cosmetic cleansing gel and hair gel compositions,

Art Unit: 1617

respectively. See instant claims 30 and 31. See the formulations for additives such as perfume. See instant claim 32.

The reference fails to teach at least one phospholipid in the oil phase. Ponsanski teaches the method of preparing diluted O/W microemulsion by adding water into phospholipids-containing lipid phase without phase separation. See col. 1, lines 22 – 63. Using N-acylphosphotidyl ethanol amine in 30-95 % by weight is taught. See col. 1, lines 57 – 63; instant claims 22-25. As for the term “dilutable”, examiner notes that the reference teaches lowering viscosity of the composition by increasing the amount of water makes dilution of O/W emulsion. See col. 1, lines 22 – 57.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the microemulsion gel of Diec by incorporating the phospholipids in the oil phase as motivated by Ponsanski because 1) both references are directed to cosmetic microemulsion art; and 2) the routineer would have expected to successfully adjust the viscosity of or concentration of the cosmetic microemulsion composition while maintaining the stability of the microemulsion.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1617

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21 and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7 of U.S. Patent No. 6468551 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to oil-in-water microemulsion comprising o/w emulsifiers, lecithin or the derivatives thereof, and an optionally w/o emulsifiers.

Conclusion

No claims are allowed.

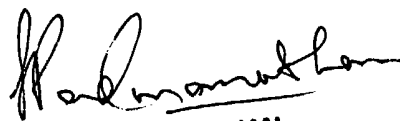
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER